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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,997	10/12/2000	Olivier De Lacharriere	196726US0	5836

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/05/2007.

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Office Action Summary

Application No.

09/686,997

Applicant(s)

DE LACHARRIERE ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13,16-24,27-33 and 36-54 is/are pending in the application.
- 4a) Of the above claim(s) 36-45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23,24 and 27-33 is/are allowed.
- 6) ☒ Claim(s) 12,13,16-22,46-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted December 29, 2006 is acknowledged.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12, 13, 16-19, 22, 46-51, 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Orentreich (IDS).

Orentreich teach a method of treating skin condition by applying to the skin a composition comprising about 1% of DHEA or its derivatives and a keratolytic agent. See, particularly, the abstract, the examples, and the claims. Such treatment would have inherently lightening the skin. Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from inherent use, absent a *haec verba* recitation for such utility. In the instant application, as in *Ex parte Novitski*, supra, the claims are directed to depigmentation or lightening of skin with old and well known cosmetic compositions. It is now well settled law that administering compounds inherently possessing a therapeutic utility anticipates claims directed to such therapeutic use. Arguments that such therapeutic use is not set forth *haec verba* are not probative. Prior use for the same utility clearly anticipates such utility, absent limitations distancing the proffered claims from the inherent anticipated use. Attempts to distance claims from anticipated utilities with specification limitations will not be

Art Unit: 1617

successful. At page 1391, *Ex parte Novitski*, supra, the Board said "We are mindful that, during the patent examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 219 (CCPA 1975)". In the instant application, Applicants' failure to distance the proffered claims from the anticipated therapeutic utility, renders such claims anticipated by the prior inherent use. Regarding the limitation "in need of depigmentation and/or bleaching" It is noted that such limitation would read on those who need to improve his/her skin homogeneity of color, and would be applicable to most of the people who are willing to use cosmetics. Who does not want to improve his/her skin homogeneity or color? It is particularly true for those who are exposed (or have been exposed) to intensive UV light.

Claims 12, 13, 16-18, 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenbaum (US Patent 5,869,090).

Rosenbaum teaches a method of treating skin conditions by applying a composition comprising about 1% of DHEA to the skin. See, particularly, the abstract, examples 9-13 and claims 19 and 25. As discussed above, such treatment would have inherently lightening the skin. Regarding the limitation "in need of depigmentation and/or bleaching" It is noted that such limitation would read on those who need to improve his/her skin homogeneity of color, and would be applicable to most of the people who are willing to use cosmetics. Who does not want to improve his/her skin homogeneity or color? It is particularly true for those who are exposed (or have been exposed) to intensive UV light.

Claim Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12, 13, 16-22, 46-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobuo et al. (JP 07196467, IDS submitted August 25, 2005) and Orentreich (4,542,129 of record), in further view of Tokue et al.

5. Orentreich teach a method of treating skin condition (dry skin) by applying to the skin a composition comprising about 1% of DHEA or its derivatives and a keratolytic agent. See, particularly, the abstract, the examples, and the claims. Nobuo et al. teaches that DHEA stimulating the certification of cuticle and enabling to expected improvement in roughed skin and the prevention (suppression) in the aging of the skin (see the abstract provided in the IDS).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use the composition of Orentreich for general cosmetic purpose, such as improving the general condition of skin and suppression of the aging of the skin, since DHEA has been known to provide such benefit. The further incorporation of UV screening agents into the composition disclosed by Orentreich for the purpose of improving the general condition of skin and suppression of the aging of the skin would have been obvious to one of ordinary skill in the art, since it is well-known in cosmetic art that UV light is known as a factor causing the aging of skin and employment of UV screening agents, such as

Art Unit: 1617

benzophenone derivatives, for suppressing skin aging is known in the art. See, e.g., the claims in Tokue et al. It is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is the employment of a combination of two known anti-skin aging agents sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. Regarding the limitation “in need of depigmentation and/or bleaching” It is noted that such limitation would read on those who need to improve his/her skin homogeneity of color, and would be applicable to most of the people who are willing to use cosmetics. Who does not want to improve his/her skin homogeneity or color? It is particularly true for those who are exposed (or have been exposed) to intensive UV light.

6. Further, it is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant’s attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated “is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various functions. The ultimate utility for the claimed compounds is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Response to the Augments

Applicants' amendments, exhibits and remarks submitted December 29, 2006 have been fully considered, but are not persuasive with respect to the rejections set forth above.

Applicants contend that there are many different types of skin colors exists. Applicants also point out the exit of albinos, whose skin is extremely light. Applicants argue that practice the method of Orentreich, or Rosenbaum would not inherently practice the claimed invention, which requires a subject "in need of" depigmentation or bleaching. The arguments are not persuasive. As discussed in the prior office action, the "in need of" limitation recited herein fails to distinct the claimed invention from the prior art. Jansen case is misused in this situation. In Jansen, the population be treated by the claimed method in Jansen is clearly limited to a very specific population, i.e., "human which anemia is caused by ether folic deficiency or by vitamin B[12] deficiency." Furthermore, all the cases cited by applicants are fact specific and should not be

applied as a per se rule. Applicants' definition of inherent "something that is inherent must **inevitable** be the result **each and every time**" is groundless on the current law and is simply not true. The nature of instant invention and related art, is for treatment of a mass population.

Therefore, practice the method of prior art would inevitably practice the claimed invention.

In response to applicant's argument that the cited references do not teach or suggest depigmentation, or bleaching, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Art Unit: 1617

The working examples in a patent do not constitute the full scope of the invention or teaching of the patent. The cited patents by Orentreich, or Rosenbaum as a whole teach treatment of human skin with DHEA.

Applicants are reminded that the invention have been examined are directed to a method of depigmentation and/or bleaching of skin, wherein the treated skin does not have particular pigmentation marks. See, restriction requirements mailed July 2, 2003. Therefore, arguments regarding freckles are moot.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shengjun Wang
Primary Examiner
Art Unit 1617

S Wang
SHENGJUN WANG
PRIMARY EXAMINER